

REMARKS

Claims 16 - 20 are now pending in this application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks.

REJECTION TO CLAIMS 11 -15

Claims 11 -13 were rejected under 35 U.S.C. § 112, first paragraph in the office action dated 07/24/2002 for introduction of new matter. Claims 14 -15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,384,993 to Goddard et al. in the recent office action dated 01/14/03 , and the previous office action dated 10/10/02

These rejections are respectfully traversed. Claims 11 -15 have been canceled. Applicant requests that the rejections be reconsidered and withdrawn.

NEW CLAIMS 16 - 22

New claims 16 - 20 have been added. The invention as claimed is a fish hook or lure having a metal body which is exposed for contact with water. A coil winding is formed around the body. The winding is also of a metal exposed for contact with water and is electrically insulated from the metal body by a nonconductive layer between the body and winding. The body and winding are of dissimilar metals so that upon immersion in water the resulting electrolytic action upon the two dissimilar metals results in the generation of an enhanced electromagnetic field to attract fish.

Rejections under 35 U.S.C. § 112, first paragraph in the office action dated 07/24/2002 for introduction of new matter failed to set forth express findings of fact which support the rejection , nor were supportable amendments suggested to the applicant. Concessionary amendments were made without argument in order to make a *bona fide* attempt to advance the application to finality. Unfortunately this has resulted in adverse further office action and as such the issue of new matter need be addressed.

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction. Specifically in question is the nature of the claimed insulation layer which is obvious when 'as a whole' the functional characteristics coupled with the known and disclosed correlation between function and structure necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it .The invention claimed is of an electromagnetic parameter and consists of , as disclosed, a conductive winding, an insulation layer, and a conductive core. It would be obvious to one skilled in the art that the insulation layer is nonconductive as both the winding and core are clearly and explicitly disclosed as being conductive. Furthermore the Merriam-Webster's Collegiate Dictionary defines the word insulate as "to place in a detached situation : Isolate; *especially*: to separate from conducting bodies by means of nonconductors so as to prevent transfer of electricity, heat, or sound". There is no disclosure in the application to suggest thermal or acoustic properties and admissions to such would be perverse. The specification clearly states 'to generate differential charges in the two dissimilar conductors (i.e. the fish hook and the winding)' and therefor demands that the insulating layer is nonconductive.

The applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. It is therefore clear from the

application as filed that the applicant intended a particular definition and that intended definition reflects the 'plain meaning' of the term. Pending claims must be given the broadest reasonable interpretation consistent with the specification while original claims constitute their own description. The PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims, while an applicant may show possession of an invention by disclosure of drawing that are sufficiently detailed to show that the applicant was in possession of the claimed invention as a whole. In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.

Furthermore, referring to U.S. Patent No. 4,970,808 to Massie, Massie establishes claim in Claim 1(e) (column 2 line 56 and 57) 'electrically insulated from' after a disclosure in the specification (column 2 line 28) of an 'insulator fitting-9'. Therefore U.S. Patent No. 4,970,808 to Massie establishes a clear precedent for the 'plain meaning' of terms in relation to the pending application.

Claims 14 -15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,384,993 to Goddard et al.. In the recent office action dated 01/14/03 pg. 2 the Examiner erroneously states that Goddard et al. discloses a winding-12 of 'fine color'. Goddard does disclose a winding 'of a bright color' (column 1 line 15) and 'of a different color to that of the body' (column 2 line 15) and it would be obvious to one skilled in the art that the best method to preserve a bright color in a corrosive environment would be to paint the winding to insure a long-lasting contrast to the body. Goddard et al. also discloses a 'fine metal strip' as a winding and it would be obvious to one skilled in the art that fine would suggest delicacy and flexibility to suit its inherent use (i.e. a means of attachment to the hook). Goddard further discloses a 'strip' as the preferred winding which is contrary to the invention now claimed and fails to expressly or impliedly suggest the claimed invention. Referring to the Merriam-Webster's Collegiate Dictionary 'strip' is defined as 'a long narrow piece of a material' and it would be obvious to one skilled in the art that such a material would not be an appropriate material to form a wire coil.

Further, the office action utilizes impermissible hindsight by applying an improper 'obvious to try' rationale in relation to the winding-12, and the hook-6 in Goddard et al. by suggesting that the winding disclosed by Goddard would likely be composed of stainless steel while it is commonly known by those in the art that quality fish hooks are often composed of stainless steel and thus the disclosure of Goddard would in no way render the current application obvious. Goddard et al. Fig 1 and Fig 4 clearly show the winding-12 and the hook-6 directly adjacent to each other and thus fails to disclose that the body-10 is a nonconductive insulating layer as disclosed in the current application. Furthermore as the color of the body-10 of Goddard is essential to the functionality of the disclosed invention, and the disclosed invention suggests the preferred embodiment of the winding-12 as 'having spaced coils and being of a different color to that of the body-forming mass-10.' the proposed obviousness would render the prior art invention being modified unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification. Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art does not necessarily possess the characteristics of the pending claims and as a whole includes disclosures that teach away from the currently claimed invention.

To support a rejection under 35 U.S.C. § 103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, the applicants claimed invention would have been obvious. Motivation to make or use the non-obvious product must be present in the prior art. Obviousness cannot be predicated on what is not known at the time an invention is made even if the inherency of a certain feature is later established. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient, and the level of skill in the art cannot be relied upon to provide the suggestion to combine references.

The office action of 01/14/03 further argues the generation of electromagnetic fields by dissimilar metals is obvious through the prior art. It is commonly known by those of ordinary skill in the art that any and all conductive mediums placed in an electrolyte will produce an electromagnetic field, however none of the prior art relied upon teaches or renders obvious the relationship of winding and core in the production of an enhanced electromagnetic field to attract fish as in the current application. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In contrast U.S. Patent No. 4,218,975 to Ream discloses a toroidal coil to create 'an output voltage' as a means for detecting electromagnetic fields and for firing or controlling an ordinance device and in no way renders obvious the currently claimed invention.


In contrast U.S. Patent No. 6,247,261 to Kechriotis discloses an electromagnetic field as the result of galvanic reaction upon a linearly oriented cathode-anode arrangement of metals and similarly fails to teach or render obvious the currently claimed invention.

None of the prior art made of record and not relied upon teaches or renders obvious the claimed invention of the body of exposed metal, the exposed winding disposed around the body and insulated therefrom, with the winding and body being formed from dissimilar metals so as to generate an enhanced electromagnetic field by electrolytic action when the winding and body are exposed to contact with water when immersed therein.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed or accommodated. Applicant therefor respectfully requests that the Examiner reconsiders and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding office action. The applicant who is a small entity resident overseas is available by telephone should the Examiner avail themselves to make a *bone fide* attempt to advance the application proceedings to finality.

Respectfully submitted


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